



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,929	07/26/2001	Chris A. Barton	NAI1P014/01.128.01	8771

28875 7590 09/16/2005

Zilka-Kotab, PC
P.O. BOX 721120
SAN JOSE, CA 95172-1120

EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/916,929

Applicant(s)

BARTON ET AL.

Examiner

Kevin Schubert

Art Unit

2137

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Art Unit: 2137

The 131 Affidavit has been reconsidered in response to the applicant's remarks filed 8/4/05.

Upon reconsideration, the 131 Affidavit does NOT overcome the prior art rejection and place the application in condition for allowance.

5 The applicant attempts to show conception of the invention prior June 13, 2001 coupled with due diligence from prior to the reference date to the filing of the application on July 26, 2001. However, the Affidavit is improper for at least the three reasons that it 1) merely recites general allegation of patentability, 2) does not properly show due diligence, and 3) does not support conception of the claimed invention.

10 **1. General Allegation of Patentability**

15 "A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of the conclusion, is insufficient to satisfy 37 CFR 1.131" (See MPEP 715.07).

20 "The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a generation assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant**" (See MPEP 715.07).

25 The applicant's Declaration presented on 6/22/05 and again on 8/4/05 is comprised of the following statement followed by a recitation of the claimed invention: "I,..., hereby state that the invention in the above patent application was conceived at a date prior to June 13, 2001, as evidenced, at least in part, by EXHIBIT A". Both this statement and the recitation of the claimed invention are mere allegations that the Affidavit teaches the claimed invention which do not provide sufficient explanation as to how this conclusion is derived. Applicant provides no indication as to how the exhibit supports conception of the claimed invention. There is no "clear explanation" and as such applicant has failed to meet the burden of establishing conception of the claimed invention.

30

Art Unit: 2137

2. Diligence

5 "Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence" (See MPEP 715.07(a)).

10 In contrast to the guidelines for showing diligence, the applicant has merely submitted the following statement: "It is hereby declared that applicants acted diligently from a time prior to the effective date United States Patent Application 2002/0194212 up to reduction to practice or the filing of the above application". Again, the applicant has merely provided an allegation of diligence without showing "evidence of facts establishing diligence" as required by the MPEP.

3. Affidavit Does not Teach the Claimed Invention

15 The Affidavit does not support conception of the claimed invention. For example, the examiner finds no support for the limitation "wherein it is determined whether the data meets a predetermined criteria, where the criteria is based on a type of a file associated with the data", the limitation "wherein the data is sent to the scanning co-processor if it is determined that the data meets the predetermined criteria", or the limitation "wherein additional data to be scanned by the scanning co-processor is queued while waiting for the results from the scanning co-processor". The examiner notes that this is not a comprehensive list and that other deficiencies may be present as well.

25

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER